



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,213	01/12/2007	Henrike Lotz	P2107-299	5911
2352 7590 07/08/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER TSAY, MARSHA M				
ART UNIT		PAPER NUMBER		
1656				
MAIL DATE		DELIVERY MODE		
07/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,213

Applicant(s)

LOTZ ET AL.

Examiner

Marsha M. Tsay

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 25-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Firstly, it is also acknowledged that the telephonic interview conducted between Examiner and Applicants' representative, Mark Farley, was indeed on April 6, 2009, and not on December 30, 1899, as indicated on the Interview Summary form PTOL-413. The incorrect date was inadvertently transcribed.

Applicant's election with traverse of Group VI, claims 23-24, to SEQ ID NOS: 1 and 2 and Candida and Trichosporon, in the reply filed on April 10, 2009 is acknowledged. The traversal is on the ground(s) that at least the method claim(s), to the degree they are restricted to the specific Rbr1p protein which is characterized by SEQ ID NOS: 1 and 2 and is connected with the Group VI claims. Applicants' remarks are persuasive regarding at least having a method claim that is connected with the Group VI claims rejoined. Therefore, the restriction between Group V and Group VI is withdrawn, since Group V is drawn to a method claim that appears to be connected with Group VI. Regarding Applicants' remarks that the technical feature linking Groups I-XIV is not candida albicans cell wall but rather is the specific candida albicans cell wall protein Rbr1p, which said Rbr1p is not taught in the cited Sohn et al. reference. Applicants' remarks have been considered but are not persuasive to overcome the restriction of the remaining claims because the Groups are still drawn to different inventions, i.e. structurally different compositions and methods having different steps, wherein each different invention has a different technical feature. The restriction is withdrawn between Groups V-VI and is maintained and made final for Groups I-IV, VII-XIV.

Upon review of the previous restriction, however, it appears that the previous restriction requirement was incomplete. Therefore, a further restriction is deemed necessary as set forth below.

Claims 1-21, 25-38 have been withdrawn from further consideration by the Examiner because they are drawn to non-elected inventions. Claims 22-24 are at issue.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 22-24, drawn to a method for the discovery and identification of substances having therapeutic action against diseases which are caused by *Candida* species or pathogenic fungal *Trichosporon*, wherein a substance to be tested is brought into contact with at least one agent, wherein the agent is selected from the group consisting of nucleic acid, a vector, a host cell, a protein, and an antibody, and a composition comprising an agent identified according to method 22.

Group I is subject to further restriction. Applicants are required to further elect an agent. This is NOT an election of species. Applicants are asked to select an agent from either group (1) nucleic acid, vector, host cell, protein, (2) antisense nucleic acids, and (3) an antibody. The characteristics of antisense nucleic acids and an antibody are chemically, functionally, and structurally different than the protein (i.e. SEQ ID NO: 2).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marsha M. Tsay whose telephone number is (571)272-2938. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 1656

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maryam Monshipouri/

Primary Examiner, Art Unit 1656

July 1, 2009